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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,133	02/18/2004	Benoit Barabe	50037.220US01	5200

27488 7590 03/02/2007
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EXAMINER

ALI, OMAR R

ART UNIT	PAPER NUMBER
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2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/782,133

Applicant(s)

BARABE ET AL.

Examiner

Omar Abdul-Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is in response to the original filing of February 18, 2004. Claims 1-18 are pending and have been considered below.

Information Disclosure Statement

1. The information disclosure statement filed June 9, 2006 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Specification

2. The disclosure is objected to because of the following informalities: the examiner notes the use of acronyms (e.g. ROM, RAM, etc.) throughout the specification without first including a description in plain text, as required.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 13-18 are drawn to a computer readable medium, which the applicant has defined in the specification (page 4, lines 1-10) to encompass a carrier wave. The Office considers an electronic signal to be a form of energy. Energy is not a series of steps or acts and this is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore not a compilation of matter. Thus, an electronic transmission signal does not fall within any of the four categories of invention. Therefore, Claims 13-18 are not statutory.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7, 11 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 6, 11, and 17 include the term

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"may" which is a form of indefinite language. Claims 2-7 depend on Claim 1, and include the deficiency set forth above.

7. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites the limitation "the computer-readable medium". There is insufficient antecedent basis for this limitation in the claim. The Examiner takes note that the computer-readable medium was previously mentioned in Claim 16, and thus will further examine Claim 18 as being dependent from Claim 16.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 4, 13, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzmaurice et al. (US 2004/0141015).

Claim 1: Fitzmaurice discloses a pen-mouse system, in which a glom widget menu is displayed when the widget is selected (page 3-page 4, paragraph 51), but does not explicitly disclose placing a glom widget near a current writing location. However, Fitzmaurice does disclose that the tracking menu (glom widget) follows the cursor, and

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remains stationary when moving the cursor inside the tracking menu (page 2, paragraph 36). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the widget could be placed near a writing location. One would have been motivated to place a glom widget near a current writing location so that movement across the tablet PC would be reduced.

Claim 2: Fitzmaurice discloses a pen-mouse system as in Claim 1 above, but does not explicitly disclose determining the current writing location. However, Fitzmaurice does disclose that the tracking menu (glom widget) follows the cursor, and remains stationary when moving the cursor inside the tracking menu (page 2, paragraph 36). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if the widget can be placed near a writing location, then it is inherent that the current writing location has already been determined. One would have been motivated to determine the current writing location in order to edit the text with the widget.

Claim 4: Fitzmaurice discloses a pen-mouse system as in Claim 1 above, but does not explicitly disclose placing the glom widget near the writing location further comprises placing the glom widget on a left side of the current writing location. However, Fitzmaurice does disclose that the tracking menu (glom widget) follows the cursor, and remains stationary when moving the cursor inside the tracking menu (page 2, paragraph 36). Also, Figures 28b and 28c disclose the positioning of the widget to the left of the

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cursor. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the widget could be placed at the left side of a current writing location. One would have been motivated to place the widget on the left side of the current writing location for customization purposes.

Claim 13: Fitzmaurice discloses a pen-mouse system, in which a glom widget menu is displayed when the widget is selected (page 3-page 4, paragraph 51), but does not explicitly disclose determining the current writing location or placing a glom widget near a current writing location. However, Fitzmaurice does disclose that the tracking menu (glom widget) follows the cursor, and remains stationary when moving the cursor inside the tracking menu (page 2, paragraph 36). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the widget can be placed near a writing location and it is inherent that the current writing location has already been determined. One would have been motivated to place a glom widget near a current writing location so that movement across the tablet PC would be reduced.

Claim 14: Fitzmaurice discloses a pen-mouse system as in Claim 13 above, further comprising:

a. placing the glom widget such that user movement to access the glom widget is decreased as compared to accessing a corresponding command contained within a fixed menu (page 2, paragraph 36).

Claim 17: Fitzmaurice discloses a pen-mouse system as in Claim 14 above, but does not explicitly disclose the glom widget menu may be customized. However, customizing interface menus is common in the computer arts, and it would have been obvious to one having ordinary skill in the art at the time the invention was made that the menu for the glom widget could be customized. One would have been motivated to customize the widget menu in Fitzmaurice in order to add additional operations that may be tailored towards user preferences for certain programs.

10. Claims 3, 5, 6, 7-12, 15, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzmaurice et al. (US 2004/0141015) in view of Kupka (US 7,055,110).

Claim 3: Fitzmaurice discloses a pen-mouse system as in Claim 2 above, but does not explicitly disclose placing the glom widget near the current writing location further comprises placing the glom widget based on an input language being written. Kupka discloses a system and method for a common on screen zone for menu activation and stroke input that further comprises commands or actions that correspond to font characteristics and paragraph characteristics (column 5, lines 48-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the widget in Fitzmaurice could be placed based on an input language being written. One would have been motivated to place the widget based on an input

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language being written in order to provide custom options that correspond to the language being written.

Claim 5: Fitzmaurice discloses a pen-mouse system as in Claim 2 above, but does not explicitly disclose the glom widget menu comprises a set of contextual commands associated with writing. Kupka discloses a similar system and method for a common on screen zone for menu activation and stroke input that further comprises commands or actions that correspond to font characteristics and paragraph characteristics (column 5, lines 48-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the widget menu in Fitzmaurice could include a set of contextual commands associated with writing. One would have been motivated to include contextual commands associated with writing in the widget menu in order to provide the user with commands relevant to composing a document.

Claim 6: Fitzmaurice and Kupka disclose a pen-mouse system as in Claim 5 above, but neither reference explicitly discloses the glom widget menu may be customized. However, customizing interface menus is common in the computer arts, and it would have been obvious to one having ordinary skill in the art at the time the invention was made that the menu for the glom widget could be customized. One would have been motivated to customize the widget menu in Fitzmaurice in order to add additional operations that may be tailored towards user preferences for certain programs.

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Claim 7: Fitzmaurice and Kupka disclose a pen-mouse system as in Claim 5 above, but neither reference explicitly discloses changing an appearance of the glom widget when a user hovers over the glom widget for a predetermined period of time. However, Kupka discloses alternate menus can be activated by pressing and holding a stylus button down for a moment without movement, causing the on screen cursor to change and indicate an alternate action will be performed (column 7, lines 1-11). Additionally, the Examiner considers it immaterial as to which action is performed to change the appearance of the widget because the hovering technique is a common technique in the computer arts. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the appearance of the glom widget could change by performing an action for a predetermined amount of time. One would have been motivated to change the appearance of the glom widget when an action is performed for a predetermined period of time in order to provide visual cues to the user that a new event will occur.

Claim 8: Fitzmaurice discloses a pen-mouse system comprising:

- a. display screen configured to receive user input from a pen (page 2, paragraph 36).
- b. displaying a glom widget menu when the glom widget is selected (page 3-page 4, paragraph 51).

Fitzmaurice does not explicitly disclose determining the current writing location. However, Fitzmaurice does disclose that the tracking menu (glom widget) follows the

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cursor, and remains stationary when moving the cursor inside the tracking menu (page 2, paragraph 36). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that if the widget can be placed near a writing location, then it is inherent that the current writing location has already been determined. One would have been motivated to determine the current writing location in order to edit the text with the widget.

Fitzmaurice also does not explicitly disclose placing a glom widget near the current writing location that provides access to commands associated with writing. Kupka discloses a similar system and method for a common on screen zone for menu activation and stroke input that further comprises commands or actions that correspond to font characteristics and paragraph characteristics (column ~~8~~⁵, lines 48-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the widget menu in Fitzmaurice could include a set of contextual commands associated with writing. One would have been motivated to include contextual commands associated with writing in the widget menu in order to provide the user with commands relevant to composing a document.

Claim 9: Fitzmaurice and Kupka disclose a pen-mouse system as in Claim 8 above, and Fitzmaurice further discloses:

a. placing the glom widget near the current writing location further comprises placing the glom widget such that user movement to access the glom widget is

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decreased as compared to accessing a corresponding command contained within a fixed menu (page 2, paragraph 36).

Claim 10: Fitzmaurice discloses a pen-mouse system as in Claim 8 above, but does not explicitly disclose placing the glom widget near the current writing location further comprises placing the glom widget based on an input language being written. Kupka discloses a system and method for a common on screen zone for menu activation and stroke input that further comprises commands or actions that correspond to font characteristics and paragraph characteristics (column 5, lines 48-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the widget in Fitzmaurice could be placed based on an input language being written. One would have been motivated to place the widget based on an input language being written in order to provide custom options that correspond to the language being written.

Claim 11: Fitzmaurice and Kupka disclose a pen-mouse system as in Claim 9 above, but neither reference explicitly discloses the glom widget menu may be customized. However, customizing interface menus is common in the computer arts, and it would have been obvious to one having ordinary skill in the art at the time the invention was made that the menu for the glom widget could be customized. One would have been motivated to customize the widget menu in Fitzmaurice in order to add additional operations that may be tailored towards user preferences for certain programs.

Claim 12: Fitzmaurice and Kupka disclose a pen-mouse system as in Claim 9 above, but neither reference explicitly discloses changing an appearance of the glom widget when a user hovers over the glom widget for a predetermined period of time. However, Kupka discloses alternate menus can be activated by pressing and holding a stylus button down for a moment without movement, causing the on screen cursor to change and indicate an alternate action will be performed (column 7, lines 1-11). Additionally, the Examiner considers it immaterial as to which action is performed to change the appearance of the widget because the hovering technique is a common technique in the computer arts. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the appearance of the glom widget could change by performing an action for a predetermined amount of time. One would have been motivated to change the appearance of the glom widget when an action is performed for a predetermined period of time in order to provide visual cues to the user that a new event will occur.

Claim 15: Fitzmaurice discloses a pen-mouse system as in Claim 13 above, but does not explicitly disclose placing the glom widget near the current writing location further comprises placing the glom widget based on an input language being written. Kupka discloses a system and method for a common on screen zone for menu activation and stroke input that further comprises commands or actions that correspond to font characteristics and paragraph characteristics (column 5, lines 48-61). Therefore, it

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would have been obvious to one having ordinary skill in the art at the time the invention was made that the widget in Fitzmaurice could be placed based on an input language being written. One would have been motivated to place the widget based on an input language being written in order to provide custom options that correspond to the language being written.

Claim 16: Fitzmaurice discloses a pen-mouse system as in Claim 14 above, but does not explicitly disclose the glom widget menu comprises a set of commands associated with writing. Kupka discloses a similar system and method for a common on screen zone for menu activation and stroke input that further comprises commands or actions that correspond to font characteristics and paragraph characteristics (column 5, lines 48-61). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the widget menu in Fitzmaurice could include a set of contextual commands associated with writing. One would have been motivated to include contextual commands associated with writing in the widget menu in order to provide the user with commands relevant to composing a document.

Claim 18: Fitzmaurice and Kupka disclose a pen-mouse system as in Claim 14 above, but neither reference explicitly discloses changing an appearance of the glom widget when a user hovers over the glom widget for a predetermined period of time. However, Kupka discloses alternate menus can be activated by pressing and holding a stylus button down for a moment without movement, causing the on screen cursor to change

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and indicate an alternate action will be performed (column 7, lines 1-11). Additionally, the Examiner considers it immaterial as to which action is performed to change the appearance of the widget because the hovering technique is a common technique in the computer arts. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the appearance of the glom widget could change by performing an action for a predetermined amount of time. One would have been motivated to change the appearance of the glom widget when an action is performed for a predetermined period of time in order to provide visual cues to the user that a new event will occur.

Conclusion

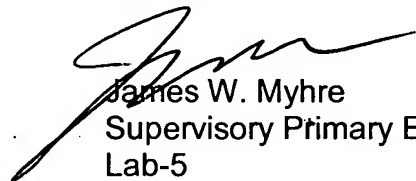
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Abdul-Ali whose telephone number is 571-270-1694. The examiner can normally be reached on Mon-Fri(Alternate Fridays Off) 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on 571-270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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02/21/07



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